

REMARKS

Applicants have considered the Examiner's comments set forth in the Office Action of November 20, 2007. No claims have been amended, and new claim 36 has been added. Claims 1, 6-16, 18, 20-27, 30, 31, and 36 are pending. Reconsideration of the application is requested.

Claims 1, 6-9, 14-16, 18, 20, 24, 25, 27, 30, and 31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawamura et al. (U.S. Pat. Pub. No. 2002/0025483), in view of Otsuka et al. (U.S. Pat. No. 5,130,222).

Claims 10-13, 21-23, and 26 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawamura, in view of Otsuka, further in view of Yuh et al. (U.S. Pat. No. 6,261,729).

Applicants traverse these rejections together.

Applicants previously argued that Kawamura did not teach an embodiment having two charge transport layers (CTLs) of equal thicknesses. The Examiner maintained the rejection on the basis that although Kawamura exemplified an invention outside the scope of the claims, it also suggests an invention, in combination with the supporting art, within the scope of the claims.

However, Applicants submit that Kawamura in combination with the support art does not suggest having two CTLs of equal thicknesses. As noted, Otsuka and Yuh disclose only embodiments having a single CTL. Applicants are unable to find a suggestion in Kawamura to make the two CTLs of equal thicknesses.

Applicants analogize the instant claims to a subgenus of the genus of dual-CTL imaging members disclosed by Kawamura. MPEP § 2144.08. Kawamura discloses that his first CTL has a thickness of about 3 to about 50 μm and his second CTL has a thickness of 0.15 to 10 μm . If the combinations of the two CTLs are made at 1 μm intervals, there are 480 combinations of CTL thicknesses (48 for 1st CTL times 10 for 2nd CTL). Of those 480 combinations, very few of them will have equal thicknesses. The Examiner stated, on page 4 of the Office Action, that it would have been obvious to produce the two CTLs at a thickness of 10 μm because a 10 μm thick second CTL is

specifically disclosed by Kawamura. Applicants are unable to find this specific disclosure and request that the Examiner note the location of this disclosure. In paragraph [0253], 10 μm is mentioned as one endpoint of the range of thicknesses for the second CTL. However, Applicants submit that this endpoint cannot be considered a specific disclosure. See, e.g., *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006) ("the disclosure of a range is no more a disclosure of the end points of the range than it is of each of the intermediate points").

Alternatively, Applicants have added new claim 36, which recites a specific total thickness of 29 microns. Support for this amendment can be found in Example II.

Applicants request withdrawal of the § 103(a) rejections.

CONCLUSION

For the reasons detailed above, it is submitted all remaining claims (Claims 1, 6-16, 18, 20-27, 30, 31, and 36) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

☒ Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	24	- 34 =	0
INDEPENDENT CLAIMS	1	- 3 =	0

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

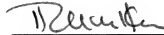
In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Richard M. Klein, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY SHARPE LLP

February 18, 2008

Date



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